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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 23

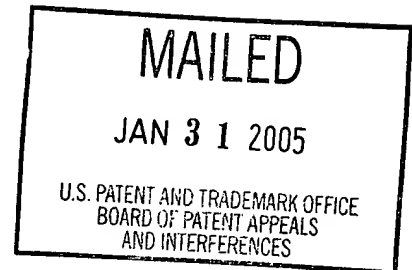
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN A. GIULIANI,
SCOTT R. VANDEVELDE,
and WALEED AL-ATRAQCHI

Appeal No. 2002-2256
Application 09/286,304¹

ON BRIEF



Before JERRY SMITH, BARRETT, and SAADAT, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON REQUEST FOR REHEARING

Appellants filed a "REQUEST FOR REHEARING" (Paper No. 22) (pages referred to as "RR__") of our decision (Paper No. 21) (pages referred to as "D__") wherein we sustained the rejection

¹ Application for patent filed April 6, 1999, entitled "Method and Apparatus for Generating Purchase Incentives Based on Price."

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of claims 10-13, 15, 17-20, 22, and 24, and reversed the rejection of claims 14, 16, 21, and 23.

We vacate the portion of the original decision concerning claims 10-13, 15, 17-20, 22, and 24, and affirm the rejection of those claims based on the examiner's original rejection.

OPINION

It is argued that we are not authorized to "sustain," but are only authorized to "affirm" (RR4). We "sustain" a rejection, but "affirm" a decision, which we did at the end of the opinion. See 37 CFR § 41.50(a) ("The Board, in its decision, may affirm or reverse the decision of the examiner"). "Sustain" means to uphold or rule in favor of, whereas "affirm" means to confirm a judgment on appeal. We see nothing wrong with our use of "sustain" to refer to a rejection, although it is also possible to say that a rejection is "affirmed."

Appellants' request for rehearing presents some good arguments which caused us to reconsider both the examiner's rejection and our decision. We now feel that our reasoning was unnecessary and that the examiner's reasoning was sufficient. Accordingly, we vacate that portion of our original opinion wherein we sustained the rejection of claims 10-13, 15, 17-20, 22, and 24, and substitute the following decision on those same claims. The request for rehearing is moot. Appellants have the right to request rehearing of this opinion.

The examiner stated (EA7):

Deaton also teaches referring to a purchase history file in providing/generating coupons when a purchase[] transaction is initiated. A purchase transaction involves the purchasing of many items. The purchase of an item involves considering a first item and the price of that first item. All other items being purchased at that instant are considered as second items. Some of these second items may also be viewed as competitive items.

Although we are not persuaded by the examiner's reasoning about the second items being competitive items, we interpret the examiner's statement to mean that an incentive based on a purchase transaction involving two or more items meets the independent claims and agree with this reasoning. As stated in our decision (D9):

The independent claims are extremely broad and do not recite any relationship between the first and second items, e.g., that they are competitive items as in claim 16, or between the price of the first and second items, e.g., based upon a difference in price between the first and second items as in claim 15. That is, the second item can be completely unrelated to the first item. It is sufficient that some other item than the first item is used to meet the dollar amount limit.

Importantly, claim 10 does not recite that the "purchase of a first item" is the purchase of a particular item, such as a competitive product. The "purchase of a first item" is broad enough to read on the purchase of any item. In our original decision, we made the mistake of reading in a requirement, not expressly called for by the claims, that the item had to be some preselected item, which caused us to combine two incentive systems. We realize now that this is unnecessary. In the

incentive system in Deaton based on the preselected criteria of the amount purchased by the customer (e.g., col. 69, lines 37-40), where two or more items are purchased, the incentive data depends on "(1) purchase of a first item," because items have to be purchased and any item can be considered a first item, and depends on "(2) a price of said first item, and (3) a price for a second item," because the incentive is based on the total combined price of the items. Appellants argue that "Claim 10 does not define the second item as contained in the same purchase transaction as the first item" (RR11); however, claim 10 does not preclude the second item from being a purchased item. Although Deaton's system depends on the purchase of each item and the price of each item, claim 10 does not preclude the incentive from being based on other criteria in addition to those expressly claimed. The rejection of claims 10-13, 15, 17-20, 22, and 24 is sustained or affirmed.

CONCLUSION

The portion of the original decision (Paper No. 21) entered September 23, 2204, concerning claims 10-13, 15, 17-20, 22, and 24 is vacated. The rejection of claims 10-13, 15, 17-20, 22, and 24 is sustained based on the examiner's rejection.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

VACATED-IN-PART and AFFIRMED

Jerry Smith
JERRY SMITH

JERRY SMITH
Administrative Patent Judge

Lee E. Barrett

LEE E. BARRETT
Administrative Patent Judge

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AND
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Wachshid D. Saadat

MAHSHID D. SAADAT
Administrative Patent Judge

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